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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,451	12/14/2001	Charles S. Taylor	GUID003CON3	1695
24353	7590	05/09/2003		
BOZICEVIC, FIELD & FRANCIS LLP 200 MIDDLEFIELD RD SUITE 200 MENLO PARK, CA 94025			EXAMINER NASSER, ROBERT L	
			ART UNIT 3736	PAPER NUMBER 15
			DATE MAILED: 05/09/2003	

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/020,451	TAYLOR, CHARLES S.
	Examiner Robert L. Nasser	Art Unit 3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 11 February 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 15, 17, 19, 26, 27, 29, 30, 33 and 34 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 15, 17, 19, 26, 27, 29, 30 and 34 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 15, 26, 29, and 33 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Takahashi et al. The examiner notes that the language in the claims stating that the device is adapted to fix a portion of the heart is intended use and is not sufficient to define over Takahashi, which discloses the identical structure as the claims.

Claims 15, 26, 29, and 34 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Palmer et al. The examiner notes that the language in the claims stating that the device is adapted to fix a portion of the heart is intended use and is not sufficient to define over Palmer et al, which discloses the identical structure as the claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 19, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi et al in view of Nishiguchi et al. Takahashi et al has only 1 suction port. Nishiguchi et al has a device for performing the identical function with a plurality of suction ports to minimize stress on the wafer at any one spot. Therefore, it would have been obvious to modify Takahashi et al to use a plurality of ports, to protect the device being picked up.

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Claims 17, 19, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Palmer et al in view of Nishiguchi et al. Palmer et al has only 1 suction port. Nishiguchi et al has a device for performing the identical function with a plurality of suction ports to minimize stress on the wafer at any one spot. Therefore, it would have been obvious to modify Palmer et al to use a plurality of ports, to protect the device being picked up.

Applicant's arguments filed 2/11/2003 have been fully considered but they are not persuasive.

Applicant has asserted that the rejection based on Takahashi et al is deficient for several reasons. First, applicant notes that the examiner stated the term adapted to fix a portion of the heart was intended use and not sufficient to define over Takahashi which discloses the same structure. Applicant cites a CCPA case stating that the term adapted to imparts a structural limitation. The examiner notes that the paddle of Takahashi et al has the same structure as the claimed member and is indeed adapted to fix a surface of the heart. That is it is indeed capable of grasping the heart and being tied off to fix the heart. Applicant is referred to In re Schreiber, for support for the examiner's position.

Second, applicant has stated that the paddle of Takahashi is intended for grasping silicon wafers and not for grasping the heart. Applicant further points out that something adapted to fix a portion of a beating heart must be made of biocompatible materials, and refers to the last 2 lines of page 9 of the specification. The examiner notes that this page of the specification provides a listing of applicant's materials, not a definition of what is necessary to make something adapted to fix a portion of the heart. In addition the paddle 32 of Takahashi et al is made of PCTFE, which is biocompatible (see 5,107,852).

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Third, applicant has stated that the forceps of Takahashi are not adapted to grasp a surface of the heart, but are intended top pick up silicon wafers. It is the examiner's position that this is an intended use limitation and, as such, is not sufficient to define over Takahashi. However, the examiner notes that, if applied to a surface of the heart, the forceps of Takahashi would indeed grasp the heart.

Fourth, applicant has stated that it is their position that recess 35 of Takahashi et al is not a suction port. Applicant supplies no support for this position. The examiner disagrees. Recess 35 is an opening in the forceps through which suction is applied. S such, it is clearly a suction port.

Fifth, applicant has asserted that Takahashi et al does not have a suction port, a suction line, and a suction aperture connecting the two. Again the examiner disagree, noting that recess 35 is the port, element 33 is the suction line, and the opening in element 32 shown to the right in figures 3 and 4 is the suction aperture.

Accordingly, it is the examiner's position that the rejection base don Takahashi et al will stand.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser Jr. whose telephone number is (703) 308-3251. The examiner can normally be reached on Monday-Thursday and alternate Fridays from 8:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg, can be reached on (703) 308-3130. The fax phone number for this Group is (703) 308-0758.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [max.hindenburg@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly

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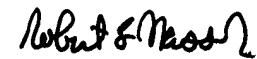
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set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.

RLN

5/2/03



ROBERT L. NASSER  
PRIMARY EXAMINER